

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7

In re Application of

LASHER et al.

Serial No. 09/512,734

Filed: February 24, 2000

For: ENHANCED DRUG DISPENSING SYSTEM



PETITION

Honorable Commissioner of
Patents and Trademarks
Washington D.C. 20231

Sir:

In response to a Notice to File Missing Parts of Application, dated March 27, 2000, submitted herewith are the following documents for filing the above-referenced application:

1. A Declaration of Inventorship signed by three of the four inventors (see enclosed);
2. An Affidavit regarding the fourth inventor, Mr. Mahar (see enclosure with Assignment document of parent application);
3. Petition for a 5 month Extension of Time; and
4. Fees, that include:
 - (1) Statutory Basic filing fee of \$690.00
 - (2) Additional claim fee of \$2,142.00
 - (3) Late Filing Fee Surcharge of \$130.00
 - (4) Assignment recordation fee of \$40.00
 - (5) Fee for 5 month extension \$1,850.00.

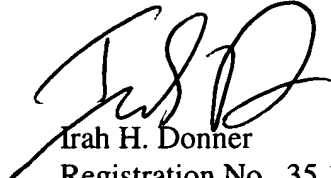
Applicant hereby petitions the Commissioner of Patents and Trademark to accept the above documents in fulfillment of all documents needed to complete the filing requirements, and to accept the application for substantive examination.

10/31/2000 KZENDIE 00000049 080219 09512734
05 FC:128 1890.00-CH

Please charge Deposit Account No. 08-0219 in the amount of \$ 4,852.00. To the extent necessary charge Applicant any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-0219 and please credit any excess fees to such deposit account.

Respectfully submitted,

HALE AND DORR LLP


Ira H. Donner
Registration No. 35,120

1455 Pennsylvania Avenue, NW
Washington, DC 20004
TEL 202.942.8585
FAX 202.942.8484
Date: 10/27/00
IHD/sgs: 103864-1101

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

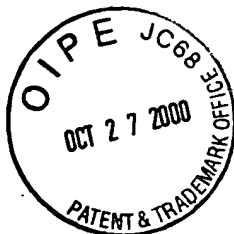
In re Application of

LASHER et al.

Serial No. 09/512,734

Filed: February 24, 2000

For: ENHANCED DRUG DISPENSING SYSTEM



AFFIDAVIT

Honorable Commissioner of
Patents and Trademarks
Washington D.C. 20231

Sir:

Refusal of an inventor to sign a declaration may be overcome by submitting an affidavit of the facts, the required fee, and the last known address of the non-signing inventor, according to 37 CFR §1.47, as amplified in MPEP 409 and MPEP 409.03(d).

I hereby submit this affidavit pursuant to 37 CFR §1.47 that one inventor of the referenced application, a Mr. Michael L. Mahar has refused to respond to various attempts, and therefore, has refused to sign a declaration of inventorship. Upon information and belief, the following facts of Mr. Mahar's conduct, pointing to a refusal, are:

Mr. Mahar signed an Assignment agreement assigning the invention described in application 08/250,435 with Medco Containment Services, Inc. ("Medco"), and he clearly and in plain language agreed to assign to Medco all of his inventions made in connection with application 08/250,435 (see enclosure).

When additional inventors were to be added to application number 08/250,435, Mr. Mahar objected, and refused to sign the Declaration declaring himself the sole inventor, even though the claims were submitted that included the contribution of other Medco Containment employees. Since Mr. Mahar had already officially assigned his rights in the invention, a continuation-in-part application (CIP) was filed listing Mr. Mahar as an inventor along with the three other co-inventors. This CIP application, application number 08/455,402, having the identical disclosure as application number 08/250,435, was assigned to Medco Containment as well by the remaining co-inventors, see enclosure. Mr. Mahar subsequently refused to sign the declaration in the CIP. A Petition to Accept the Application under 37 C.F.R. 1.47 was similarly submitted and granted in the CIP application. CIP application number 08/455,402 matured into U.S. Patent 5,720,154, which is the subject of this reissue application, application number 09/512,734. Accordingly, Medco Containment, predecessor corporation to Merck-Medco Managed Care, owned and currently owns the entire title and interest in the present reissue application.

The undersigned made several attempts at locating and contacting Mr. Mahar. Mr. James M. Hunter, Jr. of Merck-Medco mailed Mr. Mahar the reissue application and the combined declaration/power of attorney at his last known address, a copy of this letter is enclosed.

The undersigned called three different telephone numbers listed in the New York area for Mahar received from directory assistance, including (607) 797-7213, (914) 462-3899 and (914) 255-7108. On each telephone call, the call was answered and the person answering the telephone indicated that no Michael Mahar existed. In addition, the undersigned telephoned Mr. Mahar's former employer at Innovation Associates, (607) 798-9376. The former employer indicated that they had not been in contact with Mr. Mahar for several years. the undersigned also telephoned the last known address of Mr. Mahar, listed below, at (717) 728-9314. The person who answered the telephone indicated that Mr. Mahar had not been at that location for some time, and did not indicate whether she would in fact forward the message, or whether the letter to Mr. Mahar was ever received.

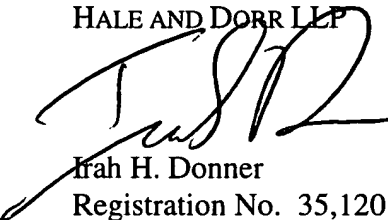
The last known address of Mr. Mahar is:

822 Anthony Drive
Mechanicsburg, PA 17055

I, Irah H. Donner, do hereby affirm that, to the best of my knowledge, the facts of the case are as stated above. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or Imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

HALE AND DORR LLP



Irah H. Donner
Registration No. 35,120

1455 Pennsylvania Avenue, NW
Washington, DC 20004

TEL 202.942.8585

FAX 202.942.8484

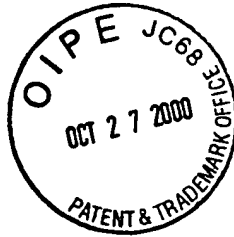
Date: 10/27/00

IHD/sgs: 103864-1101



Merck-Medco
Managed Care, L.L.C.

100 Parsons Pond Drive,
Franklin Lakes, NJ 07417-2603
201-269-3400



October 13, 2000

Mr. Michael L. Mahar
822 Anthony Drive
Mechanicsburg, PA 17055

Re: Enhanced Drug Dispensing System
U.S. Reissue Patent Application Serial No. 09/512,734

Dear Mr. Mahar:

Enclosed herewith for your review and execution is a combined Declaration and Power of Attorney for the above-referenced patent application. A photocopy of the original application and the reissue claims are also enclosed for your review.

The reissue application is an attempt to broaden the original claims issued in the initial patent. Therefore, the original patent has been surrendered to the U.S. Patent and Trademark Office for re-examination of the broadened claims. After you have executed the declaration, kindly return the same to us for forwarding to the Patent Office.

Should you have any questions or wish to discuss this matter, please contact me at your earliest convenience at 732-594-8317.

Very truly yours,

James M. Hunter, Jr.
Senior Attorney – Patents

Enclosures:

1. Combined Declaration/Power of Attorney; and
2. Reissue Patent Application.

A-19067.C



PATENTS

IN THE UNITED STATES PATENT OFFICE

In re the Patent Application of :
MICHAEL L. MAHAR ET AL. :
Serial No. 08/455,402 : Art Unit:
Receipt Date: May 31, 1995 : Examiner:
For: ENHANCED DRUG DISPENSING :
SYSTEM :

PETITION UNDER 37 C.F.R. 1.47 AND
RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Attention: Application Processing Division
Special Processing and Correspondence Branch

Sir:

The above-identified application was filed by the joint inventors Christopher J. Lasher, Dennis Wayne Rice and Michael Joseph Szesko on behalf of themselves and on behalf of the joint inventor, Michael L. Mahar, who refused to execute the application. Proof of the pertinent facts of the refusal to execute the application by the joint inventor Michael L. Mahar were submitted in a declaration filed with the application and executed by William Halsch, who is associate counsel for the assignee of the above-identified application. As shown in Mr. Halsch's declaration, Mr. Mahar refused to execute the declaration. Accordingly, it is submitted that the other three inventors are entitled to file the application on behalf of themselves and on behalf of Mr. Mahar under 37 C.F.R. 1.47 and it is requested that the application be accepted on that basis. The last known address of Michael L. Mahar is 21 Overbrook Drive, Appalachin, New York 13732.

A Notice to File Missing Parts of Application and a Notice of Incomplete Application were issued in this case. The Notice of Incomplete Application indicated that a filing date had not been granted because allegedly the original application papers did not

include at least one claim. This notice was in error in that the original application papers did include claims and this fact has now been confirmed by Kathy Kirik in the Application Processing Division. Accordingly, it is submitted that a filing date of May 31, 1995 should be granted to this application.

The fee of \$130 for the Petition Under 37 C.F.R. 1.47 and the surcharge of \$130 assessed in connection with the Notice to File Missing Parts, together with a copy of the Notice to File Missing Parts of Application and Notice of Incomplete Application, are enclosed herewith.

The Notice to File Missing Parts indicates that the signature of Michael Mahar was missing. However, since the application is being filed under 37 C.F.R. 1.47, Mr. Mahar's signature is not required. The original filing papers may, however, be considered incomplete since they failed to include a petition under 37 C.F.R. 1.47 and the petition fee. Thus, the submission of this Petition and the petition fee provides the complete application papers and is a complete response to the Notice to File Missing Parts.

If the Commissioner finds that additional fees are required or that a refund is in order, he is authorized to appropriately debit or credit Deposit Account No. 12-0275.

Respectfully submitted,

Date: July 18, 1995

Richard L. Aitken
Richard L. Aitken
Registration No. 18,791

Lane, Aitken & McCann
Watergate Office Building
2600 Virginia Avenue, N.W.
Washington, D.C. 20037
(202) 337-5556

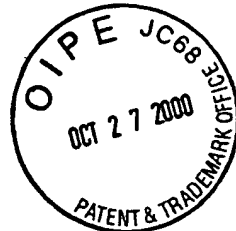
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date of signature identified below.

Richard L. Aitken, Registration No. 18,791

Signature: Richard L. Aitken
Date of Signature: July 18, 1995

A-19067.C



PATENTS

IN THE UNITED STATES PATENT OFFICE

In re the Patent Application of :
MICHAEL L. MAHAR ET AL. :
Serial No. 08/455,402 : Art Unit:
Filed: Herewith : Examiner:
For: ENHANCED DRUG DISPENSING :
SYSTEM :

SUPPLEMENTAL DECLARATION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Attention: Special Program Law Office
Office of Deputy Assistant Commissioner
for Patent Policy and Projects
Crystal Park 1, Suite 250
Washington, D.C. 20231

Sir:

William Halsch declares that:

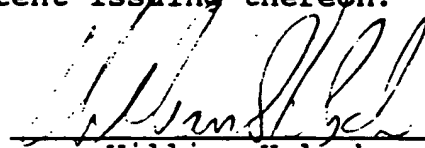
He is the person who signed the declaration submitted with the application showing that the inventor, Michael L. Mahar, refused to execute the application.

He himself personally presented the application to Michael L. Mahar with the declaration naming all four inventors as joint inventors and Michael L. Mahar made his refusal to sign the declaration to him personally.

William Halsch declares further that all statements made herein of his own knowledge are true and that all statements made

on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 10/16/95



William Halsch